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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/653,601	09/02/2003	Robert J. Lysaght	00-VE20.59 DIV1	5075

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EXAMINER	
NGUYEN, DUC MINH	
ART UNIT	**PAPER NUMBER**
2643	

DATE MAILED: 08/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/653,601	LYSAGHT ET AL.	
	Examiner	Art Unit	
	Duc Nguyen	2643	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 28-34 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 28-34 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 28-34 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 of U.S. Patent No. 6,614,880 in view of Ubowski (6,389,125). Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reasons: claims 1-2 of U.S. Patent No. 6,614,880 clearly cover claims 28, 30, 33-34. Claims 1-4 of U.S. Patent No. 6,614,880 do not teach a DTMF decoder to decode the received line number data signals.

Ubowski teaches the use of a DTMF decoder to decode the received line number data signals (caller ID information; column(s) 5, line(s) 20-63; column(s) 6, line(s) 61 through column(s) 7, line(s) 5; see claim 11 and claim 15) for the purposes of sharing call related information between multiple telephone devices (column(s) 2, line(s) 28-32).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the teachings of Ubowski into the teachings of U.S. Patent No. 6,614,880 for the purposes mentioned above.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 28, 30 and 33-34 are rejected under 35 U.S.C. 102(e) as being anticipated by Avitsur et al (6,201,854).

Consider claims 28, 33. Avitsur teaches an automated telephone set apparatus comprising test circuit means (test equipment 16) for applying test signals to a telephone line (14) to be tested, the test circuit means including a means for applying dialing signals to the telephone line (column(s) 3, line(s) 57-65); a memory (database 30; column(s) 4, line(s) 60-65); and programmable means (MMI and processing unit 24) connected to the test circuit means (16) and the memory (30) for controlling the apparatus; the apparatus being programmed to firstly store in the memory assignment data indicative of a telephone number corresponding to the telephone line to be tested (database 30; column(s) 4, line(s) 60-65; column(s) 5, line(s) 23-31); the apparatus being programmed to secondly apply dialing signals (column(s) 3, line(s) 42-65; column(s) 4, line(s) 45-59; column(s) 6, line(s) 2-14) to the telephone line to actuate a line identification facility at a central office (12); receive line number data signals indicative of a telephone number corresponding to the telephone line from the line identification facility at the central office to which the dialing signal were applied (column(s) 4, line(s) 45-59); decode the received line number data signals (column(s) 4, line(s) 45-59); retrieve the stored assignment

data from the memory (column(s) 4, line(s) 45-59; column(s) 6, line(s) 14-44); compare the telephone number indicated by the retrieved assignment data with the telephone number indicated by the received and decoded line number data signal (column(s) 6, line(s) 14-44); and indicate whether the telephone line tested was the intended subject of the test assignment (column(s) 6, line(s) 14-44).

Consider claims 30, 34. Avitsur teaches an automated telephone set apparatus comprising test circuit means (test equipment 16) for applying test signals to a telephone line (14) to be tested, the test circuit means including a means for applying dialing signals to the telephone line (column(s) 3, line(s) 57-65); a memory (database 30; column(s) 4, line(s) 60-65); and programmable means (MMI and processing unit 24) connected to the test circuit means (16) and the memory (30) for controlling the apparatus; the apparatus being programmed to firstly store in the memory assignment data indicative of a telephone number corresponding to the telephone line to be tested (database 30; column(s) 4, line(s) 60-65; column(s) 5, line(s) 23-31); the apparatus being programmed to secondly apply dialing signals (column(s) 3, line(s) 42-65; column(s) 4, line(s) 45-59; column(s) 6, line(s) 2-14) to the telephone line to actuate a line identification facility at a central office (12); receive line number data signals indicative of a telephone number corresponding to the telephone line from the line identification facility at the central office to which the dialing signal were applied (column(s) 4, line(s) 45-59); decode the received line number data signals (column(s) 4, line(s) 45-59); retrieve the stored assignment data from the memory (column(s) 4, line(s) 45-59; column(s) 6, line(s) 14-44); compare the telephone number indicated by the retrieved assignment data with the telephone number indicated by the received and decoded line number data signal (column(s) 6, line(s) 14-44); and

indicate whether the telephone line tested was the intended subject of the test assignment (column(s) 6, line(s) 14-44).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 29, 31, and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Avitsur et al (6,201,854) in view of Ubowski (6,389,125).

Consider claims 29, 31, and 32. Avitsur teaches an automated telephone set apparatus comprising test circuit means (test equipment 16) for applying test signals to a telephone line (14) to be tested, the test circuit means including a means for applying dialing signals to the telephone line (column(s) 3, line(s) 57-65); a memory (database 30; column(s) 4, line(s) 60-65); and programmable means (MMI and processing unit 24) connected to the test circuit means (16) and the memory (30) for controlling the apparatus; the apparatus being programmed to firstly store in the memory assignment data indicative of a telephone number corresponding to the telephone line to be tested (database 30; column(s) 4, line(s) 60-65; column(s) 5, line(s) 23-31); the apparatus being programmed to secondly apply dialing signals (column(s) 3, line(s) 42-65; column(s) 4, line(s) 45-59; column(s) 6, line(s) 2-14) to the telephone line to actuate a line identification facility at a central office (12); receive line number data signals indicative of a telephone number corresponding to the telephone line from the line identification facility at the

central office to which the dialing signal were applied (column(s) 4, line(s) 45-59); decode the received line number data signals (column(s) 4, line(s) 45-59); retrieve the stored assignment data from the memory (column(s) 4, line(s) 45-59; column(s) 6, line(s) 14-44); compare the telephone number indicated by the retrieved assignment data with the telephone number indicated by the received and decoded line number data signal (column(s) 6, line(s) 14-44); and indicate whether the telephone line tested was the intended subject of the test assignment (column(s) 6, line(s) 14-44). Avitsur does not teach a DTMF decoder to decode the received line number data signals.

Ubowski teaches the use of a DTMF decoder to decode the received line number data signals (caller ID information; column(s) 5, line(s) 20-63; column(s) 6, line(s) 61 through column(s) 7, line(s) 5; see claim 11 and claim 15) for the purposes of sharing call related information between multiple telephone devices (column(s) 2, line(s) 28-32).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the teachings of Ubowski into the teachings of Avitsur for the purposes mentioned above.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Duc Nguyen whose telephone number is 571-272-7503. The examiner can normally be reached on 7:00AM- 3:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis Kuntz can be reached on 571-272-7499. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Duc Nguyen
Primary Examiner
Art Unit 2643

8/16/05